

REMARKS/ARGUMENT

This Amendment is being filed in response to the Office Action dated July 1, 2005. Reconsideration and allowance of the application in view of the amendments made above and the remarks to follow are respectfully requested.

Claims 1-23 were pending in this application. Claims 1, 17, 18, 19, 20, 22, and 23 are independent claims.

In the Office Action, the abstract states "scheduler" which should in fact be "schedule" as indicated. The abstract is amended herein in accordance with the recommendation contained in the Office Action. It is respectfully submitted that the abstract is now in proper form and an indication to that effect is respectfully requested.

Claims 1, 2, 7-9, 17-23 are rejected under 35 U.S.C. §102(e) as anticipated by U.S. Patent Publication No. 2005/0028208 to Ellis ("Ellis"). Claims 3-6 are rejected under 35 U.S.C. §103(a) as unpatentable over Ellis in view of U.S. Patent Publication No. 2002/0124262 to Basso ("Basso"). Claims 3 and 6 are rejected under 35 U.S.C. §103(a) as unpatentable over Ellis in view of U.S. Patent Publication No. 2002/0071540 to Dworkin ("Dworkin"). Claim 10 is rejected under 35 U.S.C. §103(a) as unpatentable over Ellis in view of Basso in further view of Dworkin. Claim 14 is rejected under 35

U.S.C. §103(a) as unpatentable over Ellis in view of U.S. Patent No. 6,226,793 to Kwoh ("Kwoh"). Claim 15 is rejected under 35 U.S.C. §103(a) as unpatentable over Ellis in view of U.S. Patent No. 6,097,878 to Saib ("Saib"). Claim 16 is rejected under 35 U.S.C. §103(a) as unpatentable over Ellis in view of U.S. Patent Publication No. 2004/0181814 to Ellis ("Ellis2").

Ellis shows (emphasis provided) "a system [that] may allow the user to access important feature's of the user's in-home program guide from a remote location and set program guide settings for those feature's." (See, page 1, paragraph 0010.) The Office Action takes the position that a person (the user) at work is a different person (the user) than the same person at home. This position is not supported by Ellis. However, in the interest of expediting allowance of this application, Claims 1, 17, 18, 19, 20, 22, and 23 are amended to clarify the present inventive features. It is respectfully submitted that Ellis does not disclose or suggest (emphasis provided) "[a] method for automatic recording, the method comprising the steps of: receiving a request, from a scheduler, to schedule a recording of a program for a recipient; and issuing a command to record the program for the recipient if the recipient has authorized the scheduler to schedule a recording,

wherein the scheduler and the recipient are different individuals"
as required by Claim 1, and as substantially required by each of
Claims 17, 18, 19, 20, 22, and 23. Accordingly, it is respectfully
submitted that Claims 1, 17, 18, 19, 20, 22, and 23 are allowable
over Ellis and an indication to that effect is respectfully
requested.

Based on the foregoing, the Applicants respectfully submit
that independent Claims 1, 17, 18, 19, 20, 22, and 23 are
patentable over Ellis and notice to this effect is earnestly
solicited. Claims 2-16 and 21 respectively depend from one of
Claims 1 and 20 and accordingly are allowable for at least this
reason as well as for the separately patentable elements contained
in each of said claims. Accordingly, separate consideration of
each of the dependent claims is respectfully requested.

For example, Ellis does not disclose or suggest "the step of
determining if the scheduler is authorized to schedule a recording
for the recipient" as required by Claim 2. The Office Action takes
the position that "[i]t is necessarily included that if the
scheduler access features of the program guide via the remote
access device to record a program for the recipient or the home
user, then the scheduler is authorized to schedule a recording for
the recipient." It is respectfully submitted that this logic is

flawed since the claim requires the step of determining ... which may not be performed and the user may still be enabled to schedule a recording as in Ellis.

Ellis in view of Basso or Dworkin does not disclose or suggest "wherein the step of determining if a scheduler is authorized to schedule a recording for the recipient further comprises the step of determining if the scheduler matches an entry in a buddy list" as required by Claim 3 and as substantially required by Claims 6 and 10. Basso and Dworkin are relied on for showing this feature, however, this reliance is misplaced.

Basso shows access to home content if the user is on a buddy list (see, paragraph 29), not authorization to schedule a recording. Dworkin is not even a related art in that it relates to a video conferencing system, so may not be suitably combined. Paragraph 2 of Dworkin is not even related since it only discusses registered users having access to a teleconference system. The Office Action takes the position that "it would have been obvious at the time the invention was made to modify Ellis to include a buddy list as taught by Basso in order to allow users to record items of interest for their friends as disclosed by Basso."

However, Basso is related to a user allowing friends to have access to recordings (see, paragraph 34) and Dworkin has nothing to

do with recording items of interest or even friends for that matter, as pointed out above.

Ellis in view of Basso or Dworkin does not disclose or suggest "wherein the step of determining if the scheduler matches an entry in a buddy list further comprises the step of determining if a scheduler personalized television recorder identification matches one of a plurality of identifications in the buddy list", as required by Claim 5 for the reasons pointed out above. The Office Action takes the position that this feature is inherent in both Basso and Dworkin. This further position is also respectfully refuted.

In response to the inherency arguments in the Office Action (here and for other prior art combination rejections), Appellant respectfully notes that a missing element is inherently present in a reference only if that element necessarily follows from what has been expressly described, and would be so recognized by one of skill in the art. Mere possibilities or even probabilities are not enough; necessity recognized by those of skill in the art is required.¹

1 The Federal Circuit has clearly set out the standard for inherency in, e.g., Continental Can Co. v. Monsanto Co., 20 U.S.P.Q.2d 1746, 1749 (Fed. Cir. 1991)(emphasis added):

To serve as an anticipation when the reference is silent about the asserted inherent characteristic, such gap in the reference may be filled with recourse to extrinsic evidence. Such evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference and that

The M.P.E.P. echoes this case law.

The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic.

M.P.E.P. § 2112 (emphasis in original)(citations omitted).

Further, the following is also emphasized:

In relying upon the theory or inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teaching of the applied prior art.

M.P.E.P. § 2112 (emphasis in original)(citations omitted).

It is well established that a recited element or step is inherently present in a prior art reference only if that element is necessarily present or necessarily performed in that reference, and further that its presence or performance would be recognized by one of ordinary skill in the art from what has been expressly described. Second, the Office Action must provide objective evidence or cogent technical reasoning to support a contention of

it would be so recognized by persons of ordinary skill. In re Oelrich, 212 U.S.P.Q. 323, 326 (C.C.P.A. 1981) (quoting Hansgird v. Kemmer, 40 U.S.P.Q. 665, 667 (C.C.P.A. 1939)) provides: "Inherency, however may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient."

This citation is also set out in M.P.E.P. § 2131.01(d).

inherency.

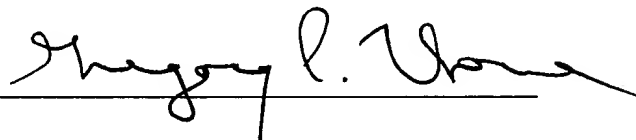
Neither of these requirements are met by the citation in the Office Action, and accordingly, neither of Basso or Dworkin inherently disclose this feature.

In addition, Applicant denies any statement, position or averment of the Examiner that is not specifically addressed by the foregoing argument and response. Any rejections and/or points of argument not addressed would appear to be moot in view of the presented remarks. However, the Applicant reserves the right to submit further arguments in support of the above stated position, should that become necessary. No arguments are waived and none of the Examiner's statements are conceded.

Applicant has made a diligent and sincere effort to place this application in condition for immediate allowance and notice to this effect is earnestly solicited.

Early and favorable action is earnestly solicited.

Respectfully submitted,

By 

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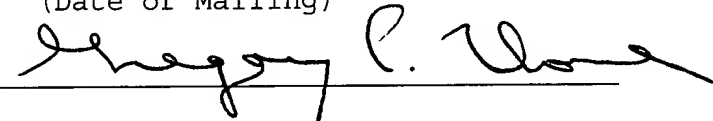
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